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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,475	02/21/2002	Hideyuki Ban	HITA.0173	4858

7590

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EXAMINER

TOMASZEWSKI, MICHAEL

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 07/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/078,475	BAN ET AL.	
	Examiner	Art Unit	
	Mike Tomaszewski	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>21 February 2002</u> . | 6) <input type="checkbox"/> Other: _____ |



DETAILED ACTION

Notice To Applicant

1. This communication is in response to the application filed on 21 February 2002.

Claims 1-8 are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

- (A) For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural

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phenomena that do not apply, involve, use, or advance technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, exemplary claim 1 is drawn to a health management support method comprising the step of entry...; getting...; generating...; preparing...; and estimating. It is not clear whether or not the recited steps of entry, getting, generating, preparing, and estimating actively apply, involve, use, or advance the technological arts. In particular, these acts are capable of being performed in the human mind or via paper and pencil. As such, there is no specific requirement with the language of the claim to a practical application WITHIN the technological arts, as there is no requirement for any of the recited steps to be performed electronically or via computerized database components.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, exemplary claim 1 is drawn to a health management support method, system and healthy life expectancy prediction data generation method and system, and as such, appears to produce a useful, concrete, and tangible result, namely an inventory of specialized items.

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 1 is deemed to be directed to non-statutory subject matter.

(B) Dependent claims 2-8 fail to further recite a positive and definite limitation to the technological arts, and also fail to pass muster under 35 U.S.C. 101.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Summerell et al. (5,937,387; hereinafter Summerell).

(A) As per claim 1, Summerell discloses a health management support method comprising:

- (i) a health screening report data entry step which comprises getting health screening report data for each person who underwent health screening (Summerell: col. 8, line 50-55; Fig. 3);
- (ii) a personal healthy life expectancy prediction data generating step which comprises preparing healthy life expectancy prediction data beforehand as

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basic data for predicting healthy life expectancy and generating personal healthy life expectancy prediction data from the health screening report data for a person, using the healthy life expectancy prediction data (Summerell: col. 9, lines 32-67; col. 10, lines 1-67; col. 11, lines 1-15; Fig. 7-17 and 30); and

- (iii) a personal healthy life expectancy prediction step which comprises estimating a predicted period of healthy life expectancy of said person, using the generated personal healthy expectancy prediction data (Summerell: col. 11, lines 16-29 and 60-61).

(B) As per claim 2, Summerell discloses a health management support method as recited in claim 1 further comprising:

- (i) a health management plan generation step which comprises generating health management plans for each person who underwent health screening, based on the predicted value of healthy life expectancy of each person estimated in the personal healthy life expectancy prediction step (Summerell: col. 16, lines 51-67; col.17, lines 1-27; Fig. 17-29).

(C) As per claim 3, Summerell discloses a health management support method as recited in claim 2, wherein the health management plan generation step comprises health screening plan generation steps for generating health screening recommendation plans (Fig. 18-29).

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Note that Examiner considers the phrases “*Consult your doctor before starting any Wellness plan,” “Consult your doctor before starting any age reduction strategy,” and the like to be health screening recommendation plans.

(D) As per claim 4, Summerell discloses a health management support method as recited in claim 2, wherein the health management plan generation step further comprises healthy life-style plan generation steps generating practice recommendation plans for guiding each person improving his or her living habits such as meals, exercise, and smoking (Fig. 18-29).

In particular, Summerell specifically discloses recommendation plans pertaining to meals (24), exercise (24) and smoking (Fig. 23).

(E) As per claim 5, Summerell discloses a health management support method as recited in claim 2, further comprising:

- (i) a health management effect prediction step which comprises estimating change to the predicted period of healthy life expectancy of a person, the change expected, assuming that the person would practice life-style improvement advised in a health management plan generated the in the health management plan generation step (Summerell: col. 16, lines 51-67; col. 17, lines 7-27; Fig. 18-22).

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(F) As per claim 6, Summerell discloses a health management support method as recited in claim 5, further comprising:

- (i) a medical payment prediction step which comprises preparing medical payment prediction knowledge data beforehand as basic data for predicting medical payment from a diversity of healthy life expectancy and calculating change to medical payment predicted for a person who underwent health screening, based on the change to the predicted period of healthy life expectancy of the person estimated in the health management effect prediction step and through the use of the medical payment prediction knowledge data (Summerell: col. 4, lines 65-67; col. 5, lines 1-11).

(G) As per claim 7, Summerell discloses a health management support method as recited in claim 1, further comprising:

- (i) a medical payment prediction step which comprises preparing medical payment prediction knowledge data beforehand as basic data for predicting medical payment from a diversity of healthy life expectancy and calculating predicted medical payment that each person who underwent health screening may pay in future, based on the predicted period of healthy life expectancy of each person estimated in the personal healthy life expectancy prediction step and through the use of the medical

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payment prediction knowledge data (Summerell: col. 4, lines 65-67; col. 5, lines 1-11).

(H) As per claim 8, Summerell discloses a health management support method as recited in claim 1, further comprising:

- (i) a medical insurer management support step which comprises predicting aggregate medical payment of a medical insurer as a whole, based on the predicted period of healthy life expectancy of each assured person who is a policyholder insured by the medical insurer (Summerell: col. 4, lines 65-67; col. 5, lines 1-11).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied art teaches: an all care health management system (5,301,105); a system and method for developing and selecting a customized wellness plan (6,269,339); a method of managing parameters effecting the comprehensive health of a health user (6,458,080); and a method of auditing public health (6,527,712).

The cited but not applied art also includes non-patent literature articles by: V. Kerry Smith ("Longevity Expectations and Death: Can People Predict Their Own Demise?" Sep. 2001. The American Economic Review. Vol. 91, Iss. 4. pgs. 1126.)

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and John C. Erfurt ("The Cost-Effectiveness of Worksite Wellness Programs for Hypertension Control, Weight Loss, Smoking Cessation, and Exercise" Spring 1992. Vol. 45, Iss. 1. pgs. 5 and 23.).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Tomaszewski whose telephone number is (571)272-8117. The examiner can normally be reached on M-F 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571)272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MT *W* 6.28.05


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